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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/292,887	04/16/1999	WARREN S. WILCOX	354533-00201	4136
37509	7590	10/28/2004		
DECHERT LLP P.O. BOX 10004 PALO ALTO, CA 94303			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER

2121

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/292,887

Applicant(s)

WILCOX ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 26 July 2004 have been fully considered but they are not persuasive. The arguments are addressed by revision of the rejection (esp. para. 7 and 8) at expressly at para. 8, 14 and 16 below.

Claim Objections

2. Claims 47-49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims add only nonfunctional descriptive matter. See MPEP 2106.IV.B.1(b), first paragraph.
3. US patents are granted for inventions within the technological arts. Claims 47-49 add a limitation as to the kind of purchases, i.e., "purchases normally made each period of time by the credit card holder". Since the parent claims are already limited to the genus "all purchases made by the credit card holder", claims 47-49 add a specie that does not constitute a technological further limitation to the invention. That is, since the invention already claims the technology to accommodate "all purchases", no further technology would be required to accommodate any specie of said genus.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 23-32, 35-40 and 45-49 are rejected under 35 U.S.C. 103(a) as being obvious over Fernandez-Holmann.

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6. Fernandez-Holmann teaches (independent claims 23, 36 and 45) a credit card incentive system, computerized method for providing credit card incentive payments, and a computer readable medium containing a method for providing credit card incentive payments, the method comprising: establishing a credit card account for a credit card holder having an investment account at a particular financial institution that can receive periodic equal-sized payments (col. 4 lines 35-36, col. 2 lines 29-33, col. 3 lines 17-19 and col. 4 lines 49-50), said payments being made by the credit card holder (col. 4 lines 11-14); checking to determine if the credit card account is in good standing (col. 5 lines 29-38); accumulating, on a computer system, the total value of all purchases made by the card holder using the credit card during a period of time, and calculating, on a computer system, the investment benefit amount based on the accumulated value of all purchases, if the credit card account is in good standing, and transferring the investment benefit amount to the investment manager (col. 5 lines 52-63).
7. Fernandez-Holmann does not teach that the installment loan account requires a fixed number of periodic, equal-sized payments to retire the loan. Home mortgages require a fixed number of periodic, equal-sized payments to retire the loan. Because home mortgage equity is the most common household investment, and therefore the incorporation of home mortgages would encourage use of the reference invention, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add home mortgage accounts as the investment account teachings of Fernandez-Holmann.
8. Applicant argues (pp.11-13) that it would not be obvious to add home mortgage accounts as the investment account teachings of Fernandez-Holmann. The arguments are a piecemeal analysis of the reference and do not override the importance of home mortgage equity as the most common household investments. There is in particular no suggestion that the reference invention would necessitate the credit card holder incurring a debt to fund the investment. The reference teaches an investment stream funded by purchase rebates (col. 2 lines 15-21), and the reference suggests that the reference invention can be used for extra payments only.
9. Fernandez-Holmann does not teach that said transferring the installment loan benefit amount is applied as an extra payment. However, Fernandez-Holmann does teach that an existing investment account can be used (col. 4 lines 49-50), so it would have been obvious

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to one of ordinary skill in the art, at the time of the invention, to apply the installment loan benefit amount to an existing home mortgage, for which said transferring the installment loan benefit amount would be applied as an extra payment.

10. Fernandez-Holmann inherently teaches that said extra payment reduces the cost of the installment loan since all payments necessarily reduce the lifetime interest paid on the loan, which reads on reducing the cost of the loan.
11. Fernandez-Holmann does not teach determining if there is an outstanding balance on the credit card holder's installment loan/investment account. Because it is good practice to verify that a loan has not been paid off before making a payment, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determining if there is an outstanding balance on the credit card holder's installment loan/investment account.
12. The limitation *credit card issuer* computer system is an ownership limitation that is nonfunctional descriptive material, and was accordingly not given patentable weight. See MPEP 2106.IV.B.1(b), first paragraph.
13. Fernandez-Holmann also teaches claim 28 at the citations given above. Fernandez-Holmann also teaches claims 31 and 39 (col. 6 line 17) and claim 40 (col. 5 lines 63-65).
14. Applicant argues (p. 14, "item 8") that the reference does not teach an additional payment of principal. That is not correct. Any additional payment on a mortgage necessarily results in an additional payment of principal. (See in para. 5 of the final rejection mailed on 28 January 2002.)
15. Fernandez-Holmann does not teach (claims 24, 37 and 46) determining if the loan has been refinanced. This is obvious for the reason given in para. 11 above.
16. Applicant argues (p. 14, "item 9") that the reference does not contemplate an installment loan receiving the benefit. The reference teaches "funding the investment account ... with a predetermined amount of money on a periodic basis" (col. 2 lines 35-36), which reads on an installment payment. The extension to the payment funding a mortgage is obvious.
17. Fernandez-Holmann does not teach (claims 25, 26 and 27) that the benefit amount is transferred by wire and/or check. Because these are common instruments each useful in some circumstances, it would have been obvious to one of ordinary skill in the art, at the

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time of the invention, to add transfer of the benefit amount by wire and/or check to the teachings of Fernandez-Holmann.

18. Fernandez-Holmann does not teach (claims 29-32, 35 and 38) that the payment period is one year. Because some customers may prefer a longer period, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add one year to the periodic payment teachings of Fernandez-Holmann.
19. Fernandez-Holmann inherently teach (claims 47-49) that at least some of the credit card purchases are purchases normally made each period of time by the credit card holder. Fernandez-Holmann teaches rebates based on credit card purchases without limitations (col. 2 lines 15-21). There is no suggestion to exclude purchases normally made each period of time.
20. Claims 33, 34 and 41-44 are rejected under 35 U.S.C. 103(a) as being obvious over Fernandez-Holmann in view of Simpson. Fernandez-Holmann does not teach that the benefit amount is based on the value of interest charged. Simpson teaches that the benefit amount is based on the value of interest charged (col. 1 lines 46-58). Because it would make the reference invention more attractive to some customers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Simpson to the teachings of Fernandez-Holmann.

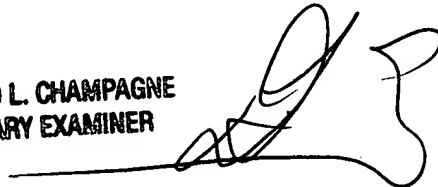
Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The examiner's supervisor, Anthony Knight, can be reached on 571-272-3687.
24. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
25. Applicant may have after final arguments considered and amendments entered by filing an RCE.
26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER



Donald L. Champagne
Primary Examiner
Art Unit 2121

23 October 2004